



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SMITH *et al.*

Appl. No. 09/902,789

Filed: July 12, 2001

For: **Carbocyclic Hydrazino
Inhibitors of Copper-Containing
Amine Oxidases**

Confirmation No. 6639

Art Unit: 1621

Examiner: Barts, Samuel A.

Atty. Docket: 1708.0100000/IMC/AES

RECEIVED

SEP 04 2003

TECH CENTER 1600/2900

Reply To Restriction and Election of Species Requirements

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated July 31, 2003, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-8 and 34, drawn to compounds of the invention. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

In response to the Examiner's election of species requirement, Applicants hereby provisionally elect the compound of Example 4, (1*R*^{*}, 2*R*^{*})-2-(1-methylhydrazino)-1-indanol hydrogen maleate, described in the specification at page 19, as the particular chemical species to be elected for prosecution. Claims 1, 2, 3, 4, 5, 6, 7, 8, and 34 read on this chemical species.

This election is made **with** traverse. Applicants submit that the claims of restriction Groups I, II, III and IV (in particular, the claims of Groups I and IV) can be examined without serious burden on the part of the Examiner.

MPEP 803 (August 2001), at page 800-4, left-hand column, states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Thus, the Patent Office encourages examination of the entire application where such search and examination can be made without serious burden, even though separate, non-overlapping searches may be required.

In the present case, Applicants respectfully assert that a search of Groups I-IV would not impose a serious burden upon the Examiner, as a search concerning the patentability of one group would be likely to uncover art of interest to the other groups. Any additional search that would be needed would not be an undue burden on the Examiner. In particular, a search concerning the patentability of Groups I and IV would not be an undue burden on the Examiner, in light of the fact that the claims of both groups have been placed in the same class and subclasses (class 564, subclass 310+). Accordingly, in the interest of efficient advancement of prosecution, it is respectfully requested that the Examiner reconsider and withdraw the restriction requirement. Furthermore, allowance of all pending claims is respectfully requested.

In the event that the claims of Groups II-IV are withdrawn from consideration, Applicants respectfully request their rejoinder upon finding the subject matter of Group I to be allowable.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional

SMITH *et al.*
Appl. No. 09/902,789

-3-

extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No.

19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Ann E. Summerfield
Attorney for Applicants
Registration No. 47,982

Date: Sep. 2, 2003

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

::ODMA\MHODMA\SKGF_DC1;173162;1
SKGF rev 1/26/01 mac; 4/22/03 svb